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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,534

09/16/2003

Kaoru Iwato

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09/08/2006

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,534

Applicant(s)

IWATO ET AL.

Examiner

Barbara L. Gilliam

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1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7-11, 13, 14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 7-10 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed July 3, 2006 has been entered and fully considered.
2. Applicant's election without traverse of Group V, claims 11, 13-14, 16-19 in the reply filed on July 3, 2006 is acknowledged. Claims 2-5, 7-10 and 20 are withdrawn from further consideration.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim s 16 and 17 recites the limitation " M₁⁺" in claim 11. There is insufficient antecedent basis for this limitation in the claim.
 - a. In line 8 of both claim 16 and 17, "M₁⁺" is defined as being the synonymous with "M₁⁺" in general formula (2). There is no "M₁⁺" in general formula (2). General formula (2) contains "M⁺".

Claim Rejections - 35 USC § 102

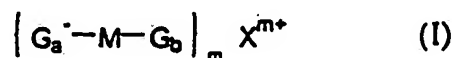
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 11, 13-14, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by NAKAMURA et al, EP 945 264 A1.

a. NAKAMURA et al. teach a positive-type photosensitive composition that has high sensitivity, good latitude in development and good storage stability and is for use in a direct plate production process using an infrared laser. The composition comprises an anionic, infrared-ray absorbing agent and a polymeric compound that is insoluble in water but soluble in an aqueous alkaline solution (abstract). Preferably the anionic, infrared-ray absorbing agent is a compound represented by general formula (I):

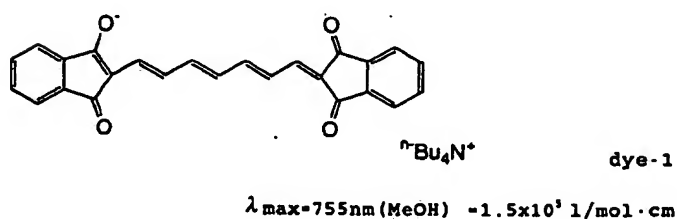
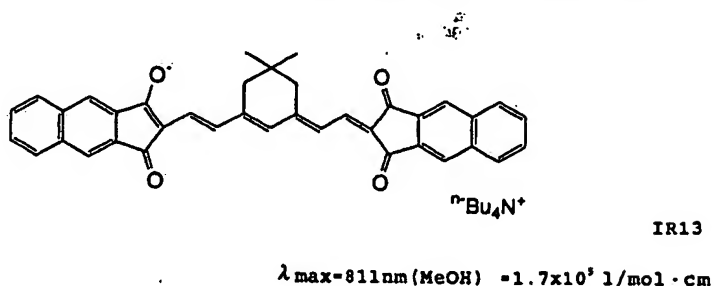
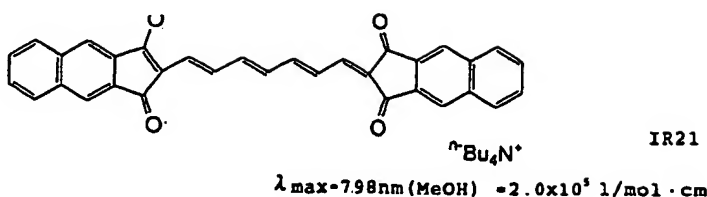


According to NAKAMURA et al., it is preferred that the anionic, infrared absorbing agent has onium salt structure counter cation which include ammonium salts, specifically the ammonium salt of formula (K):



wherein R^J , R^K , R^L and R^M may join together to form a cyclic structure ([0060], [0068]). See paragraph [0082] for specific examples of formula (K). Specific examples of the anionic dye include

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which meet the present limitations for the onium salt of general formula (2). See also compound A-22, A-30, IR-16, IR-19 - IR-22, IR-35, IR-41 - IR-43, IR-49 - IR-51. In addition to the infrared absorbing agent, NAKAMURA et al. teach with sufficient specificity that that the composition may further contain a pigment or dye capable of absorbing infrared rays.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

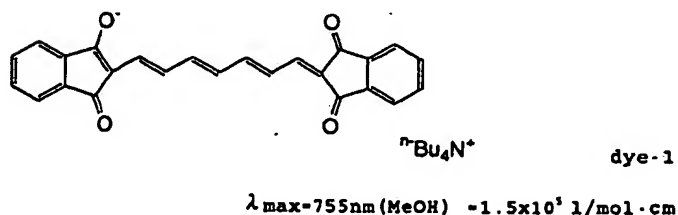
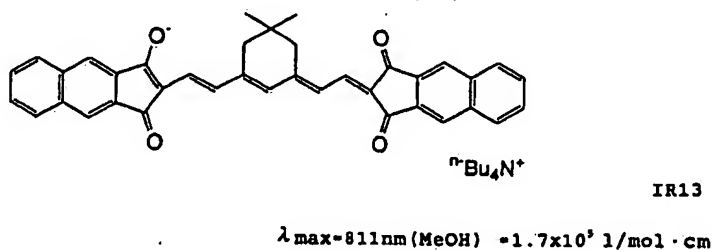
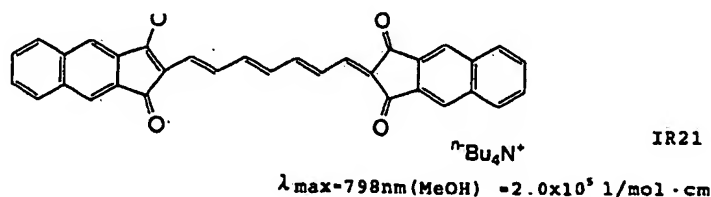
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11, 13-14, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAKAMURA et al., EP 945 264 A1.

a. As pointed out in the rejection under 35 USC 102(b), NAKAMURA et al. teach a positive-type photosensitive composition comprising an anionic, infrared-ray absorbing agent and a polymeric compound that is insoluble in water but soluble in an aqueous alkaline solution (abstract). Specific examples of the anionic dye include



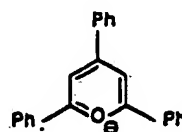
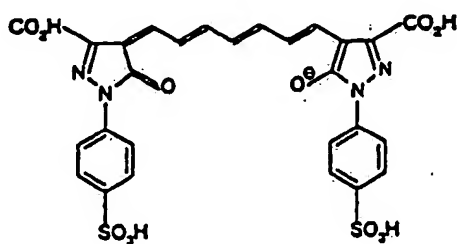
which meet the present limitations for the onium salt of general formula (2). See also compound A-22, A-30, IR-16, IR-19 - IR-22, IR-35, IR-41 - IR-43, IR-49 - IR-51. In addition to the infrared absorbing agent, NAKAMURA et al. teach with sufficient

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specificity that that the composition may further contain a pigment or dye capable of absorbing infrared rays. In the alternative it would have been obvious to one of ordinary skill in the art to add a pigment or dye capable of absorbing infrared rays in order to improve the image-forming performance ([0086]). NAKAMURA et al. also specifically teach the following anionic, infrared absorbing dyes

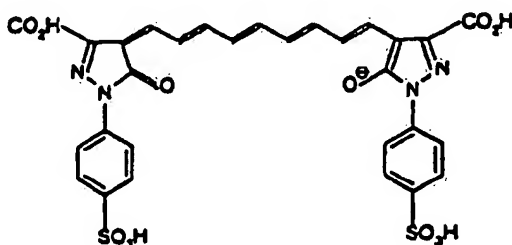
(I R-24)

(7)



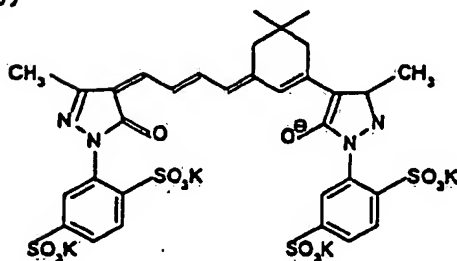
(I R-25)

(9)



(I R-26)

(7)



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which meet the structural requirements of $R^A-SO_3^-$ and $Ar^B-SO_3^-$ of general formulae (2-A) and (2-B) respectively but do not comprise the quarternary ammonium counter ion of M_1^+ (page 47-48). However, based on the overall teachings of the patent, it would have been obvious to of ordinary skill in the art to use an onium salt counter ion, such as a quarternary ammonium cation so as to exemplify the positive image formation ([0060]).

Response to Arguments

9. Applicant's arguments, filed July 3, 2006, with respect to the rejection under 35 USC 112, 1st paragraph have been fully considered and are persuasive in light of the amendment to independent claim 11. Accordingly, the rejection is withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of NAKAMURA et al., EP 945 264 A1.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In JP 2002-154279, HOSHI et al. teach a heat mode type original plate for lithographic printing. See

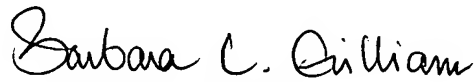
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-

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1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
September 6, 2006